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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,617	10/01/1999	DAVID MICHAEL SHACKELFORD	TU9-99-029	5644

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KONRAD RAYNES & VICTOR, LLP  
315 S. BEVERLY DRIVE  
# 210  
BEVERLY HILLS, CA 90212

EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 03/05/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/409,617

Applicant(s)

SHACKELFORD, DAVID MICHAEL

Examiner

Benjamin E Lanier

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see paper 8, filed 24 February 2004, with respect to the rejection(s) of claim(s) 1-40 under Ross have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ananda.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7-30, 33-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Ananda, U.S. Patent No. 5,495,411. Referring to claims 1-4, 7-9, 12-22, 25-30, 33-35, 38, 39, Ananda discloses a secure software rental system wherein a user requests software from a central server. The central server then generates an encrypted message and sends it to the user (Col. 11, lines 45-60), which meets the limitation of generating an encrypted message and transmitting it. The user receives and decrypts the message and sends an encrypted response to the central server (Col. 12, lines 15-34), which meets the limitation of receiving an encrypted response from the second computer system. The central server receives the encrypted message and decrypts it. The central server then compares the message using a password correlation algorithm against the stored information regarding the user processor clock time (random component, time stamp), the user identification password, and the authorization verification password (Col. 12, lines 36-46),

which meets the limitation of determining whether there is a code make available by the second computer system capable of encrypted the received encrypted response, decrypting the encrypted response with the determined code if there is one determined code, and processing the decrypted response to determine whether the second computer system is authorized to access the software. Once authorized the user is able to receive the application software (Col. 12, lines 47-53), which meets the limitation of permitting the second computer system access to the software after determining that the second computer system is authorized to access the software.

Referring to claims 10, 11, 23, 24, 36, 37, 40, Ananda discloses that the response contains the user processor clock (configuration data) (Col. 12, lines 20-25).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 6, 31, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ananda, U.S. Patent No. 5,495,411, in view of Komura, U.S. Patent No. 5,994,307. Referring to claims 5, 6, 31, 32, Ananda discloses a secure software rental system wherein a user requests software from a central server. The central server then generates an encrypted message and sends it to the user (Col. 11, lines 45-60), which meets the limitation of generating an encrypted message and transmitting it. The user receives and decrypts the message and sends an encrypted response to the central server (Col. 12, lines 15-34), which meets the limitation of receiving an encrypted response from the second computer system. The central server receives the encrypted

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message and decrypts it. The central server then compares the message using a password correlation algorithm against the stored information regarding the user processor clock time (random component, time stamp), the user identification password, and the authorization verification password (Col. 12, lines 36-46), which meets the limitation of determining whether there is a code make available by the second computer system capable of encrypted the received encrypted response, decrypting the encrypted response with the determined code if there is one determined code, and processing the decrypted response to determine whether the second computer system is authorized to access the software. Once authorized the user is able to receive the application software (Col. 12, lines 47-53), which meets the limitation of permitting the second computer system access to the software after determining that the second computer system is authorized to access the software. Ananda does not disclose using time stamps as an offset in the transmitted messages. Komura discloses a packet transmission system wherein time stamp offset values are attached to data packets (message)(Col. 7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use time stamp offset values in the system for secure software rental for synchronizing purposes taught in Komura (Col. 6, lines 40-67).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

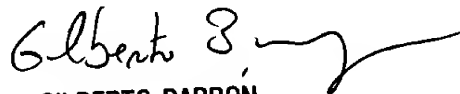
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin E. Lanier



GILBERTO BARRON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100